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Remarks

A typographic error occurs at page 8 line 12. The very last of that line reads "call 104" and it needs to be amended to read "call 140" as in the first instance of "call 140" in an earlier part of that line.

Claims 1-7 are pending in the above-identified application. The Examiner rejected claims 1-7 under 35 U.S.C. § 103(a). Previous to this amendment Applicants have canceled, without prejudice, claims 8-24. Claim 1 has been refined to more clearly define the invention. Claims 2-7 are dependent on claim 1. Independent claims 25 and 31 are newly added as are dependent claims 26-30 and 32-37. After this amendment, there are three independent claims and 17 dependent claims in this application, so no fee for extra claims is required.

Claim Rejections - 35 U.S.C. §103:

MPEP §706.02(j) states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 states:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved, as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

In the Office Action the Examiner made the following rejections.

Regarding claim 1, Griffith et al. discloses a method (fig. 5), comprising the steps of assigning a first number (538-3901) to a mobile station (112) that upon location of the mobile station at a first location (103) allows connection to the mobile station of a call that employs the first number (col. 2 lines 54-58); and assigning a second number (538-1902) to the mobile station (112) that upon location of the mobile station at a second location (104) allows connection to the mobile station of a call that employs the second number (col. 3 lines 10-16), wherein the second number (538-1902) differs from the first number (538-1901), wherein the second location (104) differs from the first location (103) (location 103 and location 104) (col. 3 lines 1-35). Griffith et al. differs from claim 1 of the present invention in that it does not disclose assigning permanent first and second numbers to a mobile station; assigning permanent user zones and temporary user zones to the mobile station; employing the first permanent number for

a connection when located in a first location; and employing the second permanent number for a connection when located in a second location or temporary zone. Saunders et al. teaches a communication device (fig. 1 number 12) comprising a plurality of number assignment modules (NAMs) (col. 5 lines 34-55); each NAM comprising a first mobile identification number (MIN1) (permanent number) assigned to a first network (fig. 1 number 14) and a second mobile identification number (MIN2) (permanent number) assigned to a second network (fig. 1 number 16) stored within its memory (col. 5 lines 11-55); employing the first (NAM/MIN1) for a connection when located in a first location (home site) (col. 4 lines 35-54); and employing the second (NAM/MIN2) permanent number for a connection when located in a second location or temporary zone (visitor or roam system) (col. 4 lines 35-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Griffith et al. method with assigning permanent first and second numbers to a mobile station; assigning permanent user zones and temporary user zones to the mobile station; employing the first permanent number for a connection when located in a first location; and employing the second permanent number for a connection when located in a second location or temporary zone in order for the wireless terminal to have assigned telephone numbers when working at multiple locations, which saves the wireless switching system processing and resources by not having to reassign telephone numbers to the wireless terminal based upon its location, as taught by Saunders et al.

The whole thrust of Griffith et al. is to provide a wireless terminal that can and does have its telephone number adapted/changed to operate as an additional telephone associated with a department at the location it is being used/located as described in Griffith et al. column 1 lines 37-48, which says:

This presents many problems for companies. For example, a common problem is for an employee, after their shift is completed, to leave the department still carrying the wireless telephone; hence, the dedicated wireless telephone cannot be utilized by another employee coming on for the next shift. In addition, it is hard to determine precisely how many dedicated wireless telephones are needed for each particular department. Furthermore, if an employee comes into a particular department to lend temporary assistance for a matter of minutes, they must try to find a dedicated wireless telephone assigned to that department.

The whole purpose of Griffith is to have a wireless terminal, FIG. 1 item 112, that is not dedicated so the terminal 112 can be re assigned to a hunt group associated with the wireless terminal's location. As the user of the wireless terminal 112 is re-assigned to another location, the wireless terminal 112 is updated so that wireless terminal 112 is within the hunt group associated with the re-assigned location. There is no teaching or suggestion in Griffith that the first and second numbers assigned to wireless terminal 112 as it moves from a first location to a second location should be made permanent. In fact, if there are multiple wireless terminals in a department, the terminals will have different temporary numbers. A narrow exception does occur when the same wireless terminals are moved to the same department in the same order, then the terminals will have the same temporary numbers while in the department, but this is a very special case, which not what the problem to be solved set forth in the specification.

Saunders et al. on the other hand, solves the problem of:

In the mobile communication environment, a variety of providers and networks may offer a variety of voice and enhanced

services. One service provider may offer competitive and reliable voice service, while another provider may offer particular enhanced services suited to the needs of the customer. Also, customers may purchase and operate different equipment to provide the services they need. Existing communication technology and the lack of cooperation among different providers and networks prevents the integration and delivery of a variety of voice and enhanced services at a reasonable cost and complexity.

Saunders et al. provides the desired integration and delivery of voice and enhanced services by putting the complexities of telephone numbers and enhanced services protocols into the mobile station, FIG. 1, item 12. The do-it-all mobile station 12 uses Number Assignment Modules (NAMs) 70, 72 and 74 to communicate with the wireless voice and enhanced services that the mobile station 12 will encounter as the terminal 12 and its user move around the block, the country or the world. Saunders et al. teaches dedicating number assignment modules within a mobile station 12. The Saunders et al. approach of using the mobile station 12 to do a major portion of the communication services integration is exactly opposite to the approach of the system of Griffith et al. with ultra-flexible wireless terminals 112, 113, 114. Since Griffith et al. and Saunders et al. are so different and are going in different directions with respect to wireless technology, it is submitted that one of ordinary skill in the art would not be led or motivated to put the teaching of permanent telephone number storage technique of Saunders et al. (NAMs) into the system of Griffith et al.

There is no explicit teaching, suggestion or motivation that Griffith et al. and Saunders et al. should be combined. So, the teaching, suggestion or motivation must be implicit, which means that the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved, as a whole would have suggested to one of ordinary skill in the art

Applicants' invention as defined by claim 1. Griffith et al. is similar in technology to Applicants' claimed invention, as the Examiner has pointed out in previous Office Actions. Saunders et al. uses number-assignment-modules to put permanent telephone numbers into the mobile station 12. The Saunders et al. approach puts a large portion of the complexity and integration problem that it solves into the mobile station 12 using NAMs. So Saunders et al. is going in the direction of moving permanent telephone numbers in NAMs to the wireless station level. On the other hand, Griffith et al. and Applicants' claimed method are going in the direction of moving telephone number assignment into the base station 121 122 and/or service provider controller level 104. Because of these differences, it is submitted that one of ordinary skill would not look to Saunders et al. to modify Griffith et al. with NAMs to provide the permanent telephone numbers to solve Applicants' problem.

Further, the differences in technological direction between Griffith et al. and Saunders et al. reduces any reasonable expectation of success of their combination, assuming *arguendo* that such combination is proper. Furthermore, since the teaching or suggestion to make the combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure, it is submitted that the specific teaching or motivation to combine Griffith et al. and Saunders et al. is not present. As a whole, the combination of Griffith et al. and Saunders et al. does not make Applicants' claim 1 obvious. Again, implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved, as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Also, the only suggestion or motive to make such a combination is found in Applicants' specification and claim 1, and the teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action continues:

Regarding claim 2, Griffith et al. discloses the step of: selecting the second location to comprise a location that is noncontiguous (separate location or different room) with the first location (fig. 1 number 103 and 104).

Regarding claim 3, Griffith et al. discloses the step of selecting the first number to correspond to a first user zone that comprises the first location (col. 2 lines 54-58); and the step of selecting the second number to correspond to a second user zone that comprises the second location (col. 3 lines 10-18), wherein the second user zone differs from the first user zone (separate locations or different rooms) (fig. 1 number 103 and 104).

Regarding claim 5, Griffith et al. discloses the step of selecting the second number to allow only calls that employ the second number (538-1902) to be, contemporaneously with location of the mobile station in a temporary user zone (based upon the fixed unit in area 104 that comprises the second location, originated and/or terminated in the temporary user zone (based upon the fixed unit in area 104) (col. 2 lines 26-58 and col. 3 lines 1-34).

Regarding claim 7, Griffith et al. discloses step of assigning a particular number to the mobile station that upon location of the mobile station at any one of a plurality of locations allows connection to the mobile station of a call that employs the particular number (fig. 2 and

col. 3 lines 1-26), wherein the particular number differs from the first number, wherein each location of the plurality of locations differs from the first location (fig. 2 and col. 3 lines 1-26).

Since each of the dependent claims 2, 3, 5, and 7 include all the limitations of the respective independent claim 1, upon which they depend, these claims are also not unpatentable over Griffith et al. and Saunders et al. These dependent claims are allowable for the same reasons as independent claim 1 is allowable, and for their own characterizations.

Therefore, the rejection of claims 1-3, 5, and 7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,195,558 to Griffith et al. and U.S. Patent No. 5,918,172 to Saunders et al. has been overcome, and the Examiner is respectfully requested to reconsider and withdraw these rejections.

The Office Action continues:

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Griffith et al. in view of Saunders et al. in view of Bansal et al.

Regarding claims 4, Griffith et al. discloses a method as discussed supra in claims 1. Griffith et al. differs from claims of the present invention in that it do not disclose the step of selecting a discounted billing rate for the call that employs the second number. Bansal et al. teaches the step of selecting a discounted billing rate for the call that employs the second number (col. 5 lines 40-56 and col. 6 lines 1-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Griffith et al. with the step of selecting a discounted billing rate for the call that employs the second number in order to save money based upon a calling plan between the wireless terminal and its carrier, as taught by Bansal et al.

Claim 6 is rejected under 35 U.S.C. 103(a) as unpatentable over Griffith et al. in view of Saunders et al. as applied to claim 1-and further in view of Chavez Jr.

Regarding claim 6, the combination of Griffith et al. and Saunders et al. differs from claim 6 of the present invention in that they do not disclose the step of directing to voice mail, upon location of the mobile station at the second location, a call that employs the first number. Chavez, Jr. Teaches the step of directing to voice mail, upon location of the mobile station at the second location (wireless terminal leaves first location), a call that employs the first number (col. 5 lines 34-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the combination of Griffith et al. and Saunders et al. with the step of directing to voice mail, upon location of the mobile station at the second location, a call that employs the first number in order for the wireless terminal to replay the first number message and decide whether to respond to the message, as taught by Chavez, Jr.

With regards to the dependent claims 4 and 6 rejected under 35 U.S.C. 103(a), since each of these dependent claims include all the limitations of the respective independent claims, upon which they depend, these dependent claims are also patentable over Griffith et al. in view of Saunders et al. further in view of Chavez Jr. These dependent claims are allowable for the same reasons as independent claim 1, as well as for their own additional characterizations.

Applicants respectfully submit that the applied references, taken singly or in combination, assuming, *arguendo*, that the combination of the applied references is proper, do not teach or suggest one or more elements of the claimed invention. Applicants have discussed herein one or more differences between the cited prior art, and the claimed invention with reference to one or more parts of the cited prior art. This discussion, however, is in no way

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meant to acquiesce in any characterization that one or more parts of cited prior art correspond to the claimed invention.

Therefore, the rejections of the claims under 35 U.S.C. § 103(a) have been overcome, and the Examiner is respectfully requested to reconsider these rejections.

New independent claims 25 and 31 and dependent claims 26-30 and 32-37 further define Applicants' invention. Since independent claim 25 and 31 have all the limitations of claim 1 and further define parts of claim 1, they are likewise allowable over the cited art. Thus, the patentability of claims 25 and 31 is urged. New dependent claims 26-30 and 32-37 further define claims 25 and 31 and thus the patentability of the new dependent claims is also urged.

The prior art made of record and not relied upon is considered to be of general interest only. This application is believed to be in condition for allowance, and such action at an early date is earnestly solicited.

Respectfully submitted,



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